



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,219	04/26/2001	Lyle Theisen	P04822US0	8367

7590 06/18/2002
Zarley Law Firm PLC
Capital Square
400 Locust Street
Suite 200
Des Moines, LA 50309-2350

EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 06/18/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/843,219

Applicant(s)

THEISEN, LYLE

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 29, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Receipt is acknowledged of Amendment filed on March 28, 2002. Claims 21-32 are pending. New claim rejections are made in view of claim amendments by applicants.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term "cholesterol" in claims 21, 24, 25, 28 is used by the claim to mean " $C_{27}H_{46}O$ as well as one or more of straight chain monobasic carboxylic acids and associated fatty acids from edible fats and oils," while the accepted meaning is "animal sterol, a mono-unsaturated, secondary alcohol of the 4-ring, fused system." See Hawley, *Condensed Chemistry* (1971), p. 210. The term "cholesterol" is designated for the specific compound well known in the art. Applicants' usage of the term "cholesterol" to include carboxylic acids and fatty acids as in this case gives the a meaning repugnant to the usual meaning of that term.

Similarly, claim 24 is rejected as the term "benzene" is given a meaning repugnant to the usual meaning of the term. It appears that the term "a benzene" in

Art Unit: 1617

claims 24, is used by the claim to mean "a benzene-containing compound," while the accepted meaning term specifically refers to "a molecule having C₆H₆ arranged in a hexagon". See Carey, Organic Chemistry (1992), p. 410-411, 415-416.

The remaining claims are rejected as depending on indefinite base claims.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 21-24, 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simon (US 6080415) in view of Coates et al. (US 5188815) ("Coates"), Lemann et al. (US 6346237 B2) ("Lemann") and Motion et al. (US 5656668) ("Motion").

Simon discloses photochromic cosmetic make-up products which renders reversible coloring effect in response to light. See abstract; col. 1, line 7 – col. 2, line 5. The reference further teaches that film-forming polymers, such as formaldehyde or polyurethane polymers can be used in the invention. See col. 12, lines 25 – 36. Simon fails to teach components having thermochromic properties.

Coates teaches the thermochromic cholesteric liquid crystalline phases useful in cosmetics in general. See abstract; col. 10, lines 4 – 51; Example 7. Azobenzenes or benzylideneanilines are preferred components in the liquid crystal phase. See col. 9, lines 10 – 27.

Simon and Coates fail to teach the claimed weight range of the components in instant claim 23.

Lemann teaches cosmetic compositions comprising liquid crystal coloring agents having multiple color tones. See abstract, col. 1, line 3 – col. 4, line 52. A cyclomethicone grafted with cholesterol and biphenyl groups are disclosed. The reference teaches that these liquid crystal coloring agents may be used in 0.01- 60 % by weight. In case of nail compositions, synthetic aqueous dispersion may be used in the amount of 10-80 % by weight. See col. 10, line 47 – col. 11, line 22.

Simon, Coates, and Lemann fail to teach the pH of the prior art compositions.

Motion teaches topical compositions having pH in the range of 5.8- 7.5. See Examples 3-5.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the photochromic cosmetic compositions in Simon by adding the thermochromic liquid crystal mixtures useful for cosmetics as suggested by Coates and Lemann because of the expectation of successfully producing cosmetic composition with both photochromic and thermochromic effects. It would have been obvious to the skilled artisan that the composition should have the pH suitable for topical use, as suggested by Motion.

Nothing unexpected or nonobvious is seen in combining ingredients well known in cosmetic art. See MPEP § 718.02.

Response to Arguments

Applicant's remarks filed with the amendment have been considered but the amendment does not place the claims into allowance for reasons stated above.

Conclusion

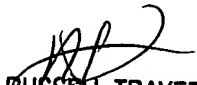
No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.


RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200

Art Unit: 1617

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
June 17, 2002

RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200